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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,165	06/15/2001	Joseph A. Manico	82117F-P	9385

7590

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EXAMINER

DIVINE, LUCAS

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,165

Applicant(s)

MANICO ET AL.

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/16/04, 6/15/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. New formal drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings submitted on 6/15/01 include illegible handwritten material as well as changes were made to the printed drawings in such a manner as to make the drawings hard to understand.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 includes the limitation '**position of said image of selected subject**'. Examiner does not understand what the position is regards to, the position of where to cut on the overall media or the position inside the image of the selected subject or a different position location. Therefore it is unclear and indefinite as to what the position claimed is in respect to. Claim 6 is rejected for being dependent, therefore inheriting the rejected limitations, of claim 5.

3. Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "**said cut sheet of media**" in the second line. There is insufficient antecedent basis for this limitation in the claim. Therefore the claim is unclear and

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indefinite as to what the cut sheet of media is and the claim is rejected for failing to particularly pointing out what the applicant regards as the invention.

◦

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 5, 7 – 9, and 16 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo (US 6519046) and Miyazaki et al. (US 619166).

Regarding claim 18, the standard practice in the printing art is to input image data, perform image processing, and then to output image data, all according to user preferences. Kinjo teaches the input of image placed in input image memory 17 (Fig. 1), processed in image processor 20, and output for printing on a digital printer 12 or at a remote location (through fax 13 or network connection). Further, in image processing steps, Kinjo teaches **a user identifying a subject within a digital image at a first location for producing a image product using a computer** (user identifies a subject by tracing an outline on pad 51, example shown in Fig. 23, wherein the user selects the head of the individual for producing an image product including the head; col. 18 lines 63-67 and col. 19 lines 1-19), **automatically differentiating the selected subject from the background of said digital image using a computer software** (image processing hardware and software then extracts the selected subject from the background as shown in Fig. 23B and 25B, wherein the extracted subject is shown as separate from the

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background; col. 19 line 31); **placing an order over a communication network using said computer, to a production facility at a second location that is remote from said first location for producing an image product using said selected subject** (Fig. 5 shows the process of ordering prints and confirming the order over a communication network [that the data sending and receiving is performed over]; the photofinishing location being remote from the user do the need for delivery); **and printing an image of said selected subject on a sheet of media** (printing shown in Fig. 5 wherein the photofinishing lab prints out the sent images).

Although Kinjo teaches the printing of a print job incorporating said subject, Kinjo does not specifically teach **producing a cut image product from said sheet of media**.

Miyazaki teaches an image input, processing, and output system that can be used at photofinishing labs such as in Kinjo. The system of Miyazaki includes printing an inputted image (by printer controller and thermal head as shown in Fig. 12) and **producing a cut image product from said sheet of media** (by cutter controller 76 and cutter shown in Fig. 12; col. 1 lines 63-65).

It would have been obvious to one of ordinary skill in the art to add the printing and cutting device of Miyazaki in the photofinishing lab of Kinjo. The motivation for doing so would have been to provide the user with many more options for output of images. The cutting pattern as cut in Miyazaki is selected by the user [col. 2 line 5] and can be cut in any arbitrary pattern [col. 14 lines 65-67] which makes it beneficial to print and cut the selected and extracted patterns of Kinjo. Further, the inventions of Miyazaki and Kinjo would be combinable because they are both developed by the same assignee [meaning there ability to be integrated with each other is

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implied] and they share some of the same photo editing and printing tasks and options [see Kinjo Fig. 33 and Miyazaki Fig. 22].

Regarding claim 1, the standard practice in the printing art is to input image data, perform image processing, and then to output image data, all according to user preferences.

Kinjo teaches the input of image placed in input image memory 17 (Fig. 1), processed in image processor 20, and output for printing on a digital printer 12 or at a remote location (through fax 13 or network connection). Further, in image processing steps, Kinjo teaches a **user identifying a subject within a digital image at a first location for producing a image product** (user identifies a subject by tracing an outline on pad 51, example shown in Fig. 23, wherein the user selects the head of the individual for producing an image product including the head; col. 18 lines 63-67 and col. 19 lines 1-19), **automatically differentiating the selected subject from the background of said digital image** (image processing hardware and software then extracts the selected subject from the background as shown in Fig. 23B and 25B, wherein the extracted subject is shown as separate from the background; col. 19 line 31); **placing an order over a communication network, to a production facility at a second location that is remote from said first location for producing an image product using said selected subject** (Fig. 5 shows the process of ordering prints and confirming the order over a communication network [that the data sending and receiving is performed over]; the photofinishing location being remote from the user do the need for delivery); **and printing an image of said selected subject on a sheet of media** (printing shown in Fig. 5 wherein the photofinishing lab prints out the sent images).

Although Kinjo teaches the printing of a print job incorporating said subject, Kinjo does not specifically teach **producing a cut image product from said sheet of media**.

Miyazaki teaches an image input, processing, and output system that can be used at photofinishing labs such as in Kinjo. The system of Miyazaki includes printing an inputted image (by printer controller and thermal head as shown in Fig. 12) and **producing a cut image product from said sheet of media** (by cutter controller 76 and cutter shown in Fig. 12; col. 1 lines 63-65).

It would have been obvious to one of ordinary skill in the art to add the printing and cutting device of Miyazaki in the photofinishing lab of Kinjo. The motivation for doing so would have been to provide the user with many more options for output of images. The cutting pattern as cut in Miyazaki is selected by the user [col. 2 line 5] and can be cut in any arbitrary pattern [col. 14 lines 65-67] which makes it beneficial to print and cut the selected and extracted patterns of Kinjo. Further, the inventions of Miyazaki and Kinjo would be combinable because they are both developed by the same assignee [meaning there ability to be integrated with each other is implied] and they share some of the same photo editing and printing tasks and options [see Kinjo Fig. 33 and Miyazaki Fig. 22].

Regarding claim 2, which depends from claim 1, Kinjo further teaches that the **produced cut image product is delivered to a remote location** (wherein the product produced at the photofinisher is delivered to a remote location to the user to receive the prints; shown in the final steps of Fig. 5).

Regarding claim 3, which depends from claim 1, both Kinjo (Fig. 33) and Miyazaki (Fig. 22) teach having multiple image products on a single sheet of media. Further then, Miyazaki teaches that these multiple images are all cut according to their shapes (col. 3 lines 43-44)

Regarding claim 4, which depends from claim 1, Kinjo further teaches that **a computer software program is used to automatically differentiate said selected subject from said background** (it is implied that image processor 20 and image processing section 65 use computer software instructions to complete the differentiation of subject from background step as well as all other image processing steps including display for the user and adding text to images as discussed throughout Kinjo).

Regarding claim 5, which depends from claim 1, Kinjo further teaches that **information regarding the position of said image of said selected subject is used for producing said cut image product** (memory stores location data for the selected subject [col. 19 lines 11-13] along with other information about the product [col. 19 lines 14-18] which is used in creating the image product).

Regarding claim 7, which depends from claim 1, one of the advantages of adding the printing apparatus of Miyazaki to the system of Kinjo as discussed above is to give the user more printing options by adding the cutting. One of the options is to make sticker prints thus printing on a sheet of media comprises an adhesive release layer and a image receiving layer having a printing side and a back side, said image receiving layer being positioned over said release layer, said back side having an adhesive layer thereon (col. 14 lines 65-67 and col. 6 line 22).

Regarding claim 8, which depends from claim 7, Miyazaki further teaches that the **cut image product is made only on said printing layer** (col. 7 lines 1-3).

Regarding claim 9, which depends from claim 1, as discussed in the rejection of claim 7, Miyazaki teaches that the **sheet of media comprises a base layer** (bottom of sticker) **and an image receiving layer** (top of sticker) **having a printing side** (printed top of sticker) **and a back side** (adhesive bottom of sticker), **said image receiving layer being positioned over said base layer** (col. 14 lines 65-67 and col. 6 line 22).

Regarding claim 16, which depends from claim 1, Kinjo teaches that the **first location comprises a customer computer** (user data terminal 51 shown in Fig. 7 which is discussed as a customer computing device in col. 10 lines 31-42).

Regarding claim 17, which depends from claim 1, Miyazaki teaches the **first location comprises a kiosk at a retail location** (in Fig. 1, Miyazaki shows a computer kiosk that can be used at any location, including those that are commonly seen and known to those of ordinary skill in the art to be at retail locations).

5. Claims 14 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claim 1 above, and further in view of Fernandez et al. (US 2002/0092215).

Regarding claim 14, which depends from claim 1, while the combination of Miyazaki and Kinjo teaches the user ordering prints with selected objects cut in them, the combination does not teach that the **cut image product comprises a free standing image having a stand section**.

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Fernandez teaches a **cut image product that comprises a free standing image having a stand section** (Fig. 5, 5a, 5b paragraph [0034], wherein a contour cut image product is a free standing image having a stand section [flap 8]).

It would have been obvious to one of ordinary skill in the art to use the combination of Miyazaki and Kinjo to produce cut image products with stands as in Fernandez. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, and freestanding images would be advantageous to a photograph print retailer. Further, a standard method of displaying a printed image is to place it in a frame with a stand. The invention of Fernandez eliminates the need for an expensive frame in order to stand an image for viewing and Fernandez in paragraphs 001, 002, and 003 discuss the art that the invention would be best suited in, including photographic reproduction art that the combination of Miyazaki and Kinjo would be included in.

Regarding claim 15, which depends from claim 14, Fernandez includes that the **stand is integrally part of said cut image product** (Fig. 5 shows that the outputted product is all one piece [including the stand flap 8] and is merely folded and set in place for the final product in 5b).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Buck (US 5851614).

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Regarding claim 12, which depends from claim 9, while the combination of Kinjo and Miyazaki teaches the printing and cutting out of stickers with an adhesive base layer, the combination does not teach that the **base layer is a transparent base layer**.

Buck teaches a cut image product where the **base layer is a transparent base layer** (shown in Fig. 1; col. 3 lines 17-21).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Miyazaki and Kinjo to print decals using a base transparent layer as taught in Buck. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Peck (US 5899010).

Regarding claim 11, which depends from claim 9, while the combination of Kinjo and Miyazaki teaches the printing and cutting out of stickers with an adhesive base layer, the combination does not teach that the **base layer comprises a static cling base layer**.

Peck teaches a cut image product where the **base layer comprises a static cling base layer** (Fig. 1 shows a cut image product which can be other images [col. 2 lines 45-59] on a static cling back layer).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Miyazaki and Kinjo to print decals using a base static cling layer as taught in

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Peck. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer. Further, the static cling base layer would allow the cut image to be adhere to plastic without leaving the adhesive residue of stickers (Fig. 2 where the static cling decals adhere to plastic backing sheet 20).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claims 1 and 9 above, and further in view of Ogikubo (US 994990).

Regarding claim 11, which depends from claim 9, while the combination of Kinjo and Miyazaki teaches the printing and cutting out of stickers with an adhesive base layer, the combination does not teach that the **base layer comprises a static flexible magnetic layer**.

Ogikubo teaches magnetic sheet for printing images on where the **base layer comprises a flexible magnetic layer** (Fig. 1 shows the layers with 2 is the printing layer and base layer 3 is a flexible magnetic layer; col. 1 lines 5-12).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Miyazaki and Kinjo to print magnets using a base magnetic layer as taught in Ogikubo. The motivation for doing so would have been to provide customers with more options of printed matter. Customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer.

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9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinjo and Miyazaki as applied to claim 1 above, and further in view of Poole (US 5962368).

Regarding claim 13, which depends from claim 1, the combination of Kinjo and Miyazaki includes media of a base and image receiving layer as discussed in the rejection of claim 9 above. And while the combination teaches using a adhesive base layer, the combination does not teach using **heat shrink film and a heat shrink base layer**.

Poole teaches a **heat shrink film including a heat shrink base layer** (Fig. 1 shows heat shrink film including printed images; col. 4 lines 15-22).

It would have been obvious to one of ordinary skill in the art that one could use the combination of Miyazaki and Kinjo to print images on heat shrink films. Further, Poole instructs to use a standard printing process (such as that of Miyazaki and Kinjo) in col. 4 lines 16-18. The motivation for doing so would to put any type of printed material onto many types of objects including baseball bats, bowling balls, bottles, etc... (see col. 3 lines 25-34). This would provide customers with more options of printed matter and customers like to customize and be creative with photographs, thus giving them options, such as custom magnets, mouse pads, stickers, labels, decals, calendars, puzzles, and freestanding images would be advantageous to a photograph print retailer.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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US-6788425, Ohtsuka et al., 9-7-2004: teaches a print order reception system for confirming print order information.

US-5974401, Enomoto et al., 10-26-1999: teaches a digital print order and delivery method and system.

US-4918611, Shyu et al., 4-17-1990: teaches a method and apparatus for controlling laser cutting by image processing.

US-6258200, Kassab, 7-10-2001: teaches a static-cling intermediary including printed images on the static-cling film.

US-6806974, Ueda et al., 10-19-2004 : teaches a print order receiving apparatus.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 703-306-3440. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

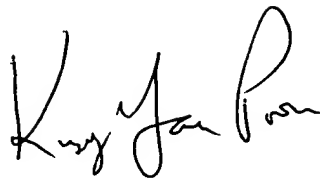
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 703-308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Lucas Divine
Examiner
Art Unit 2624

ljd

A handwritten signature in black ink, appearing to read "King Y. Poon". The signature is fluid and cursive, with the first name "King" and last name "Poon" clearly distinguishable.

KING Y. POON
PRIMARY EXAMINER